



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,096	07/30/1998	EUGENE D. THORSETT	002010-137	8518

21839 7590 08/26/2002

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 08/26/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/126,096

Applicant(s)
Thorsett et al.

Examiner
Deepak Rao

Art Unit
1624



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10, 12, 13, and 15-22 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 10, 12, 13, and 15-22 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 26 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

This office action is in response to the amendment filed on June 6, 2002.

Claims 1-4, 7, 10, 12-13 and 15-22 are pending in this application.

The following rejections are withdrawn:

The rejections under 35 U.S.C. 112, second paragraph of the previous office action are withdrawn, all except the following which is maintained.

The following rejections are maintained:

1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "4-imidazolyl" under the definition of R^5 , see page 11, line 15. There is insufficient antecedent basis for this limitation in claims 1 or 2 on which claim 12 is dependent.

Applicant's argument that the term is supported by the definition of X in claims 1 and 2 is fully considered but it is not deemed to be persuasive to overcome the instant rejection. It is agreed that as per claims 1 and 2, X can be a heteroaryl which includes "4-imidazolyl", however, claim 12 recites R^5 itself to be a "4-imidazolyl" group, which is not consistent with the base claims. According to claims 1 and 2, R^5 is $-CH_2-X$ or $=CH-X$ wherein X is various groups

Art Unit: 1624

including heteroaryl, etc. However, the group "4-imidazolyl" recited under the definition of R⁵ in claim 12 does not contain the -CH₂- or =CH- group.

2. Claims 1, 3, 4, 7, 10, 15-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Durette et al., U.S. Patent No. 6,291,511, for the reasons provided in the previous office action which are incorporated here by reference.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant relies on the amendment to claims 1, 2 and 16 wherein the definitions of the terms 'substituted aryl' and 'substituted heteroaryl' are provided and applicant argues that the claimed invention excludes R⁵ substituents that read on biaryl groups, i.e., aryl or heteroaryl groups further substituted by aryl or heteroaryl. This is not found to be the case because the definition provided for "substituted aryl" in claims 1 and 2 contains the groups 'heteroaryl' and 'substituted heteroaryl' (see claim 1, page 3, line 10; claim 2, page 7, line 16; and claim 16, page 17, line 21). Therefore, the claim continues to read on the compounds of the reference, see several of the examples in the reference: 4, 5, 50, 54, 55, 56, etc., and accordingly, the rejection is maintained.

3. Claims 2, 13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durette et al., U.S. Patent No. 6,291,511 for the reasons provided in the previous office action which are incorporated here by reference.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant argues that 'in the claimed compounds, the R⁵ substituent does not include

Art Unit: 1624

any of the biaryl groups of Durette', however, this is not found to be the case because the instant claims include aryl substituted by heteroaryl (see the explanation above) in the definition of X and therefore, the R⁵ substituent includes the substituent groups disclosed in the reference.

Accordingly, the rejection under 35 U.S.C. 103 is maintained.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7, 10, 12-13 and 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. Regarding claims 1, 2 and 16, the phrase "such as" (see claim 1, page 4, line 22; claim 1, page 5, line 25; claim 2, page 8, line 27; claim 2, page 10, line 2; claim 16, page 19, line 6; and claim 16, page 20, line 9) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
2. Regarding claims 1, 2 and 16, the phrase "and the like" (see claim 1, page 4, line 22; claim 1, page 5, line 26; claim 2, page 8, line 27; claim 2, page 10, line 3; claim 16, page 19, line 6; and claim 16, page 20, line 10) renders the claim(s) indefinite because the

Art Unit: 1624

claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

3. Claim 12 recites the limitation "4-[2'-carboxylphenoxy-]benzyl" in line 6 (under the definition of R⁵). There is insufficient antecedent basis for this limitation claims 1 or 2 on which claim 12 is dependent. Claims 1 and 2 do not recite a 'substituted aryloxy' group as one of the substituents of a 'substituted aryl' group under the definition of X.

Claims not particularly addressed above are included in the rejection because they are dependent claims and do not further resolve the above issues.

The following rejection is reinstated:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1624

Claims 1-4, 7, 10, 12-13 and 15-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 (and other dependent claims) of copending Application No. 09/126,095. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is no patentable distinction. The instant compounds are homologs of the reference compounds, i.e., they differ by a $-CH_2$ group (in the instant claims R^4 is methyl). One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds would be expected to possess similar properties and therefore, the same use as taught for the genus of the reference compounds.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection was inadvertently omitted in the previous office action. Applicants only stated that they disagree with the rejection, however, have not provided arguments traversing the rejection in the previous responses (filed on March 26, 2001 and January 24, 2002).

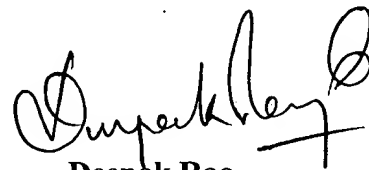
Receipt is acknowledged of the Information Disclosure Statement filed on August 5, 2002 and copy is enclosed herewith.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner

Art Unit: 1624

can normally be reached on Tuesday-Friday from 6:30am to 5:00pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a stylized flourish at the end.

Deepak Rao
Primary Examiner
Art Unit 1624

August 23, 2002